

Attorney Docket No.: DE 020298 US

REMARKSI. INTRODUCTION

Claim 1 has been amended. No new matter has been added. Claims 1-11 remain pending in the present application. In view of the above amendments and the following remarks, it is respectfully submitted that all of the pending claims are allowable.

II. CLAIM REJECTIONS – 35 U.S.C. § 101

Claims 1-9 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. (See 2/22/08 Office Action, p. 2.) Specifically, the Examiner asserts that claim 1 recites a computer program not claimed as embodied in computer-readable media. (See *id.*) The Office's position appears to be that the recitation of the "computer program" alone makes claim 1 *per se* non-statutory. Applicants respectfully disagree with the rejection. Initially, Applicants note that claim 1 is directed to a system and not to a computer program. The recited "computer program" is only one of several claimed elements of the system. MPEP 2106 defines the procedure that the Office must follow in assessing whether a claim is statutory. MPEP 2106(IV)(D) defines the *prima facie* burdens as follows:

"The examiner bears the initial burden ... of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If the record as a whole suggests that it is more likely than not that the claimed invention would be considered a practical application of an abstract idea, natural phenomenon, or law of nature, then USPTO personnel should not reject the claim. After USPTO personnel identify and explain in the record the reasons why a claim is for an abstract idea with no practical application, then the burden shifts to the applicant to either amend the claim or make a showing of why the claim is eligible for patent protection. See, e.g., *In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995); see generally MPEP § 2107 (Utility Guidelines).

Attorney Docket No.: DE 020298 US

Applicants respectfully submit and will show in detail below that the Examiner's vague explanation does not even approach a reasonable attempt to establish a *prima facie* case and that the burden has therefore not shifted to the Applicant. The Examiner's failure to establish a *prima facie* case (particularly because of lack of explanation) is reversible error. Thus, at the least, the Office should reopen prosecution and reasonably supplement its analysis.

MPEP 2106 (IV)(B) states:

The burden is on the USPTO to set forth a *prima facie* case of unpatentability. Therefore if USPTO personnel determine that it is more likely than not that the claimed subject matter falls outside all of the statutory categories, they must provide an explanation. For example, a claim reciting only a musical composition, literary work, compilation of data, >signal,< or legal document (e.g., an insurance policy) *per se* does not appear to be a process, machine, manufacture, or composition of matter. >See, e.g., *In re Nuijten*, Docket no. 2006-1371 (Fed. Cir. Sept. 20, 2007)(slip. op. at 18)("A transitory, propagating signal like Nuijten's is not a 'process, machine, manufacture, or composition of matter.' ... Thus, such a signal cannot be patentable subject matter.").

The Examiner has not provided any explanation whether the claimed subject matter falls outside all the statutory categories. Thus, the Examiner has either failed to set forth a *prima facie* case or the Examiner believes that the claimed subject matter falls within one of the enumerated statutory categories. Irrespective of the Examiner's lack of explanation, to advance prosecution meaningfully, it is noted that claim 1 recites a telematic system including *inter alia*, an operator-controlled receiving station (4) arranged to communicate with a plurality of remotely arranged calling stations (S1, S2, SN) comprising a first calling station (S1) and a second calling station (S2), characterized in that the receiving station comprises informing means (12) arranged to support an automatic transmission of a message to the first calling

Attorney Docket No.: DE 020298 US

station, to the second calling station and to an operator, and the receiving station comprises a computer program arranged to control said informing means. Thus, the claimed system is a compilation of articles of manufacture, which is statutory subject matter. It is also noteworthy that claim 1 does not only recite a computer program, but recites a number of claimed elements, which apparently have not been factored into the Examiner's analysis. The Examiner is reminded that the test under 35 U.S.C. 101 is directed to whether a claim as a whole is statutory, not whether a single element in the claim is statutory. The fact that some element in the claim is incidentally a "computer program" does not necessarily make the claim as a whole non-statutory. As a whole, claim 1 is directed to a compilation of statutory articles of manufacture.

MPEP 2106 (IV)(B) further states:

If USPTO personnel can establish a *prima facie* case that a claim does not fall into a statutory category, the patentability analysis does not end there. USPTO personnel must further continue with the statutory subject matter analysis as set forth below.

MPEP 2016 (IV)(C) states that further analysis is required based on whether there is a judicial exception or practical application, and in particular, states that:

Determining whether the claim falls within one of the four enumerated categories of patentable subject matter recited in 35 U.S.C. 101 (i.e., process, machine, manufacture, or composition of matter) does not end the analysis because claims directed to nothing more than abstract ideas (such as mathematical algorithms), natural phenomena, and laws of nature are not eligible for patent protection. *Diehr*, 450 U.S. at 185, 209 USPQ at 7; accord, e.g., *Chakrabarty*, 447 U.S. at 309, 206 USPQ at 197; *Parker v. Flook*, 437 U.S. 584, 589, 198 USPQ 193, 197 (1978); *Benson*, 409 U.S. at 67-68, 175 USPQ at 675; *Funk*, 333 U.S. at 130, 76 USPQ at 281...While abstract ideas, natural phenomena, and laws of nature are not eligible

Attorney Docket No.: DE 020298 US

for patenting, methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be. In evaluating whether a claim meets the requirements of section 101, the claim must be considered as a whole to determine whether it is for a particular application of an abstract idea, natural phenomenon, or law of nature, and not for the abstract idea, natural phenomenon, or law of nature itself.

The instant case does not involve a claim that is directed to nothing more than abstract ideas. Rather, claim 1 recites a system including *inter alia*, an operator-controlled receiving station (4) arranged to communicate with a plurality of remotely arranged calling stations (S1, S2, SN) and an informing means (12) arranged to support an automatic transmission of a message to the first calling station, to the second calling station and to an operator. Claim 1 is not only directed to a computer program. As explained in MPEP 2106, a product (or in this case a system which can be considered a product) employing a computer program can be eligible for patenting.

As further cited in the excerpt above, the claim must be considered as a whole to determine whether the claim is directed a particular application of for example natural phenomenon, or whether the claim is directed to the natural phenomenon itself. Since claim 1 as a whole recites a system with several elements that are all articles of manufacture, it is clear that the claim is not directed to a natural phenomenon itself. The fact that one element in the claim is incidentally a "computer program" does not necessarily make the claim as a whole non-statutory. As a whole, claim 1 is directed to a statutory compilation of articles of manufacture. Although the Examiner may consider a "computer program" alone to be non-statutory by itself, the application of the computer program in the claimed system is deserving of patent protection

Attorney Docket No.: DE 020298 US

III. CLAIM REJECTIONS – 35 U.S.C. § 103(a)

Claims 1, 5 and 6 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent 4,838,275 to Lee (hereinafter “Lee”) in view of U.S. Patent 6,110,108 to Shimura et al. (hereinafter “Shimura”). (See *id.*, pp. 2-3.)

Lee describes a system including devices that monitor parameters that sense a patient’s health. (See Lee, Abstract.) Signals corresponding to the sensed parameters are generated and transmitted to a surveillance office. (See *id.*) Voice communication between patients and an observer at the surveillance office supplements the electronic measurements. (See *id.*) The observer conducts routine diagnostic sessions except when an emergency is noted from one of these sessions or from a patient-initiated communication. (See *id.*)

Shimura describes a home care system in which a center terminal and a patient terminal communicate via telephone lines. (See Shimura, Abstract.) The patient terminal has an urgency transmitter device for transmitting an urgency code to the center terminal. (See *id.*) The center terminal has a receiver device for receiving the urgency code from one patient terminal while it is connected to another patient terminal, and for informing of the fact that the urgency code has been received. (See *id.*)

Claim 1, as amended, recites “[a] telematic system (1) arranged for enabling an automatic reconnection support, said system comprising an operator-controlled receiving station (4) arranged to communicate according to a communication protocol with a plurality of remotely arranged calling stations (S1, S2, SN) comprising a first calling station (S1) and a second calling station (S2), said receiving station being further arranged to enable an interrupt in the communication protocol with the first calling station upon a receipt of an interrupt request from the second calling station in order to establish a connection to the second calling station, characterized in that *the receiving station comprises informing means (12) arranged to support an automatic transmission of a message to the first calling station, to the second calling station and to an operator upon an event of enabling the interrupt in the communication protocol, the*

Attorney Docket No.: DE 020298 US

receiving station comprising a computer readable storage medium storing a computer program (6,8,10,12) arranged to control said informing means.”

When the system of Lee receives an emergency signal from a patient, the observer initiates an automated announcement in order to inform patients undergoing routine sessions that their sessions are being interrupted, and that they should await further instructions. (See Lee, col. 20, ll. 9-13.) In contrast, claim 1 recites “informing means (12) arranged to support an automatic transmission of a message to the first calling station, to the second calling station *and to an operator*.” The Examiner cites the above referenced portion of Lee in addressing this claimed limitation. (See 2/22/08 Office Action, p. 3, ll. 4-9.) However, Lee does not disclose the automatic transmission of a message “to an operator.” Rather, Lee teaches the opposite of the recitation of claim 1, in that the message is initiated *by* the operator. (See Lee, col. 20, ll. 9-13.) Shimura fails to cure this deficiency of Lee. Therefore, Lee and Shimura, alone or in combination, neither disclose nor suggest that “the receiving station comprises informing means (12) arranged to support an automatic transmission of a message to the first calling station, to the second calling station and to an operator upon an event of enabling the interrupt in the communication protocol,” as recited in claim 1. Accordingly, this rejection should be withdrawn. Because claims 5 and 6 depend from, and, therefore, include all of the limitations of claim 1, it is respectfully submitted that these claims are also allowable for at least the reasons stated above.

Claims 2-4 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Lee in view of Shimura, as applied to claim 1, in view of U.S. Patent 6,004,266 to Clawson (hereinafter “Clawson”). (See 2/22/08 Office Action, p. 4.)

Clawson describes methods and systems for receiving, processing and responding to emergency medical calls for patients with heart problems. (See Clawson, Abstract.) Clawson provides a process whereby information regarding a patient’s heart problems is gathered, categorized, and provided to medical personnel. (See id.) A dispatcher is guided through the

Attorney Docket No.: DE 020298 US

process of interrogating callers, gathering information, and providing appropriate guidance to the callers. (See id.)

Clawson fails to cure the deficiencies of Lee and Shimura described above with reference to claim 1. Therefore, Lee, Shimura and Clawson, alone or in combination, neither disclose nor suggest that “the receiving station comprises informing means (12) arranged to support an automatic transmission of a message to the first calling station, to the second calling station and to an operator upon an event of enabling the interrupt in the communication protocol,” as recited in claim 1. Because claims 2-4 depend from, and, therefore, include all of the limitations of claim 1, it is respectfully submitted that these rejections should be withdrawn.

Claims 10-11 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Lee in view of Clawson. (See 2/22/08 Office Action, p. 4.)

Claim 10 recites “[a] method of enabling an automatic reconnection support to an operator-controlled receiving station by means of a telematic system (1), said receiving station being arranged to communicate to a plurality of remotely arranged calling stations (S1,S2,SN) according to a communication protocol, said receiving station being further arranged to enable an interrupt in the communication with a first calling station upon an receipt of a interrupt request from a second calling station, said method comprising the steps of: acknowledging the interrupt request from the second calling station, *transmitting a first message to the first calling station in an automatic mode, transmitting a second message to the second calling station in an automatic mode, informing the operator about an interrupt in the communication to the first calling station, interrupting the communication to the first calling station, establishing a telematic connection to the second calling station.*”

The Applicants respectfully submit that Lee and Clawson, alone or in combination, neither disclose nor suggest a method comprising the steps of “transmitting a first message to the first calling station in an automatic mode,” “transmitting a second message to the second calling station in an automatic mode,” and “informing the operator about an interrupt in the communication to the first calling station,” as recited in claim 10, for the reasons discussed

Attorney Docket No.: DE 020298 US

above with reference to claims 1 and 2-4. Accordingly, this rejection should be withdrawn. Because claim 11 depends from, and, therefore, includes all of the limitations of claim 10, it is respectfully submitted that this claim is allowable for at least the same reasons.

The Applicants note that the Examiner fails to provide grounds for the rejection of claims 7-9 based on prior art. Therefore, the Applicants respectfully submit that any future rejection addressing these claims based on the above references should be Non-Final in order to provide the Applicants with the appropriate opportunity to address any such rejection.

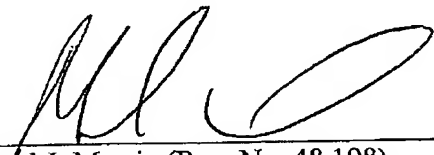
Attorney Docket No.: DE 020298 US

CONCLUSION

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

Dated: May 21, 2008

By: 
Michael J. Marcin (Reg. No. 48,198)

Fay Kaplun & Marcin, LLP
150 Broadway, Suite 702
New York, New York 10038
Tel.: (212) 619-6000
Fax: (212) 619-0276